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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,695	07/21/2000	Yulin Deng	7648.0006	4876

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EXAMINER
WILSON, DONALD R

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 08/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/621,695	Applicant(s) DENG ET AL.
	Examin r Donald R Wilson	Art Unit 1713

--The MAILING DATE of this communication appears on th cov r she t with the correspondence address --

THE REPLY FILED 28 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See attachment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,2 and 22-25*.

   Claim(s) withdrawn from consideration: *3-21 and 26-66*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Donald R Wilson
Primary Examiner
Art Unit: 1713

ADDITIONAL COMMENTS

Response to the Election of Species Requirement

1. Applicant's affirmation of the election of a copolymer of butyl acrylate and 3-methacrylamido-propyltrimethylammonium chloride (MAPTAC) as the specie of a cationic polymer, in Paper No. 12 is acknowledged. It is noted that this is interpreted to be a polymer resulting from the copolymerization of butyl acrylate and MAPTAC, as applicant specifically elected the cationic polymer as made in Example 1.

> "During a telephone conversation with Ms. Lori-Ann Johnson on 6/20/02 a further provisional election was made with traverse to prosecute the invention of the specie wherein the cationic polymer is as made in Example 1, i.e., a copolymer of butyl acrylate and 3-methacrylamidopropyltrimethylammonium chloride (MAPTAC)."

This is not a polymer made by the copolymerization of a backbone of butyl acrylate, i.e., a poly(butyl acrylate), copolymerized with MATPAC as set forth for instance in Claim 5. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 3-18 and 66 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie of the invention. Claims 26-65 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 1-2 and 22-25[1] are under consideration

Response to Proposed Amendment After Final

2. Applicant's declaration and proposed amendment filed 7/28/03, after final rejection, has been fully considered with the following results.

3. The proposed amendment will be entered upon filing of an appeal, however, this is moot because the amendment does not pertain to the claims under consideration.

4. The listing of Claims 22-25 as being withdrawn from consideration on the summary sheet and their exclusion from the list of rejected claims was an inadvertent error, which is believed should have been obvious for the following reasons:

a. Claims 22-25 were not included in the discussion of claims withdrawn from consideration, which may be found in Detailed Action § 2, 3 and 4 of the previous Office Action.

[1] See the discussion below regarding Claims 22-25.

b. Claims 22-25 depend from rejected Claim 1 and their rejection was included in the preceding Office Action (Paper No. 7) for the rejection under 35 U.S.C. § 112, first paragraph, and the prior art rejections under 35 U.S.C. § 102(b) and § 103(a).

c. At no place in the previous Office Action was it stated that the rejection of Claims 22-25 was overcome, and clearly there was no indication of allowability as alleged by applicant. If applicant had any reason to believe that claims 22-25 should have been stated as being allowable, then they could have called the Examiner for clarification, which they did not do.

d. The first office Action (Paper No. 7) clearly stated that the Examiner considered the limitations of Claims 22-25 to be intended use limitations of the adhesive compositions which did not add patentability to the claimed subject matter (Detailed Action § 23).

> "As to the limitations of Claims 22 to 25 of the adhesive forming tapes, labels, paper coatings or self-adhesive stamps, these are intended uses which also are not seen to add patentability of what is being claimed. If Claims 22-25 are amended to recite a claim to a tape, label, paper coating, or stamp they will be withdrawn from consideration as belonging to non-elected groups of inventions."

Applicant did not specifically address this statement in the response of 1/2/03, did not disagree with the Examiner, and did not amend the claims.

Thus, it is believed proper that applicant should continue to consider Claims 22-25 as being included in the stated rejections of the previous Office Action. To consider these to be new rejections would be perceived as resorting to technicalities.

5. Applicant's argument traversing the rejection under 35 U.S.C. § 112, first paragraph, is not deemed to be persuasive. It is interesting that applicant affirms the Examiner's explanation that a polymer backbone is not a monomer used to make a polymer backbone, and to treat it as such is repugnant to the term's (backbone) well known usage. Yet applicant goes on to insist that the backbone is a polymer copolymerizable with a cationically charged monomer, the inconsistency of which appears to be lost on applicant. It remains that if applicant is somehow copolymerizing another monomer with a backbone polymer that they would be obtaining a graft copolymer (or perhaps a block copolymer). However, applicant provides no enablement of how such copolymerizations can be performed. The only enablement is for the copolymerization of a cationic monomer and a non-cationic monomer to form a

copolymer, and an amendment to that effect would overcome the rejection. It remains that applicant is not copolymerizing a polymer backbone with another monomer.

6. Applicant traverses the prior art rejections relying on the same arguments used previously, i.e., that the references do not teach an adhesive composition or recite their use as adhesive paper coatings, which are not deemed to be persuasive for reasons of record. The declaration of Dr. Deng reciting that the use of the compositions is different than that of the instant invention does not change the facts. It remains that if the prior art structure is capable of performing the intended use, then it meets the claim. Applicant is again referred to M.P.E.P. § 2111.03. It is not seen that the preamble of the instant claims provides a structural difference to the adhesive compositions.

7. Applicant's argument that the art applied is non-analogous art is also not deemed to be persuasive. First, it is to be noted that the argument is only relevant to the 35 U.S.C. § 103 aspect of the rejection and cannot be used for a rejection under 35 U.S.C. § 102(b). In regards to the aspect of the rejection under 35 U.S.C. § 103(a), the determination that a reference is from a nonanalogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re* Clay, 23 USPQ.2d 1058. In as much as the applied prior art is dealing with exactly the same polymer structures as that of the instant invention it follows that the reference is reasonably pertinent both to the field of the inventor's endeavor and/or to the particular problem with which the inventor was involved

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

DONALD R. WILSON
PRIMARY EXAMINER

adv: 8/11/03